

REMARKS

This application has been carefully reviewed in light of the Official Action mailed July 28, 2005. Claim 1 is amended above. Claim 2 is canceled above without prejudice or disclaimer. Claim 14 is added above. Claims 1 and 3-14 are now pending in this case. Applicant respectfully requests reconsideration of this application and favorable action on all the remaining claims in this case in view of these amendments and the following remarks.

In the Official Action, the Examiner objected to the drawings under 37 CFR 1.84(p)(4) because reference character "70" was used to designate both flexible tubing and a light transmitting window. A replacement sheet 2 for original sheet 2 of formal drawings is attached hereto. Replacement sheet 2 deletes reference numeral "70" for the light transmitting window in Figures 2 and 3 and replaces it with reference numeral "71". A corresponding amendment is made to page 9 of the specification above. Applicant respectfully submits that the drawings are now in position for full acceptance.

In the Office Action, the Examiner rejected claims 1, 3, 5, 6, and 7 under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,661,144 to Jensen et al. ("Jensen"). Amended claim 1 requires, in a vitreoretinal instrument,

- (a) a handle; and
- (b) a cannula coupled to said handle comprising:
 - (1) a curved distal portion ***having a plane of curvature and a side port disposed at an angle of about 90 degrees to said plane of curvature***, said side port for disposing in a subretinal space for aspirating subretinal fluid; and
 - (2) a second port disposed sufficiently away from said side port so that said second port may be used for aspirating a second fluid from said vitreous cavity without removing said first port from said subretinal space;
- (c) ***a first flexible tubing having a distal end fluidly coupled to said side port and a proximal end for fluidly coupling to a vacuum source;***
- (d) ***a second flexible tubing having a distal end fluidly coupled to said second port and a proximal end for fluidly coupling to said vacuum source; and***
- (e) ***a valve disposed on said handle for selectively opening and closing said second flexible tubing.***

(emphasis added). As disclosed in the subject application, such a vitreoretinal instrument provides improved removal of subretinal fluid in combination with a fluid exchange in vitreoretinal surgery without suffering from limitations of conventional instruments. *See, e.g.*, subject specification, page 8, line 18 through page 9, line 2; page

3, line 20 through page 4, line 2.

Jensen does not disclose a side port “disposed at an angle of about 90 degrees to said plane of curvature”, as is required by amended claim 1. In contrast, side slot 17 of Jensen is disposed in the plane of curvature of its cannula 2 on either the dorsal or ventral surface of the cannula. *See* Jensen, Figures 1-2 (first embodiment), 3-4 (second embodiment), 5 (third embodiment), and 6 (fourth embodiment). In addition, Jensen contains no disclosure whatsoever regarding limitations (c), (d), and (e) of amended claim 1. For at least these reasons, amended claim 1, and its dependent claims 3-14, are novel over Jensen.

In the Official Action, the Examiner rejected the following claims under 35 USC 103 as being unpatentable: claim 2 as being unpatentable over Jensen in view of U.S. Patent No. 6,419,654 to Kadan (“Kadan”); claim 4 as being unpatentable over Jensen in view of U.S. Patent No. 5,795,323 to Cucin (“Cucin”); claim 8 as being unpatentable over Jensen in view of U.S. Patent No. 3,439,675 to Cohen (“Cohen”); claims 9-10 as being unpatentable over Jensen in view of U.S. Patent No. 5,246,436 to Rowe (“Rowe”) and further in view of U.S. Patent No. 6,193,714 to McGaffigan et al. (“McGaffigan”); claim 11 as being unpatentable over Jensen in view of Rowe and further in view of McGaffigan and U.S. Patent No. 6,325,798 to Edwards et al. (“Edwards”); claim 12 as being unpatentable over Jensen in view U.S. Patent No. 5,242,386 to Holzer (“Holzer”); and claim 13 as being unpatentable over Jensen in view of U.S. Patent No. 6,135,984 to Dishler (“Dishler”). Jensen, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, Holzer, and Dishler all fail to teach limitations (d) and (e) of amended claim 1. In contrast, Jensen, Cucin, Cohen Rowe, McGaffigan, Edwards, Holzer, and Dishler are all totally silent regarding these claim limitations. Kadan merely discloses an *irrigation channel* 26 and a suction channel 28 coupled to its handpiece 10, *not* first *and* second flexible tubing each having a proximal end for fluidly coupling to *a vacuum source*, as required by amended claim 1. *See* Kadan, column 6, lines 46-63 and column 8, lines 15-22. For at least these reasons, amended claim 1, and its dependent claims 3-14, are patentable over Jensen, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, Holzer, and Dishler.

In addition, there is no suggestion in the prior art to modify the teachings of

Jensen, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, Holzer, and Dishler so as to reach the requirements of amended claim 1, much less its associated benefits.

Absent such suggestion, any such modification would necessarily be based on the improper hindsight application of Applicant's own teachings. For additional this reason, claim 1, and its dependent claims 3-14, are patentable over Jensen, Kadan, Cucin, Cohen, Rowe, McGaffigan, Edwards, Holzer, and Dishler.

The Commissioner is hereby authorized to charge the following fee amounts required or credit any overpayment associated with the filing of this Amendment to

Deposit Account No. 501051 of Alcon, Inc.:

- 1) The fee amount of \$1020.00 for the Petition for Extension of Time for three (3) months, from October 28, 2005 to January 28, 2006, to respond to the Official Action, which is being filed concurrently with this Amendment.

The Commissioner is hereby authorized to charge any other amount required for the filing of this Amendment, or credit any overpayment, to **Deposit Account No.**

501051 of Alcon, Inc.

Should the Examiner have any questions regarding this Amendment, please feel free to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,



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